

## REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

As a preliminary matter, Applicant notes the Office Action's consideration of the Information Disclosure Statement and approval of the drawings submitted on April 2, 2004.

Claims 1-9 and 11-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,932,337 to Taniyama in view of Japanese Publication JP 04066466 to Matsuyoshi. Claim 10 is objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

By this amendment, the specification has been amended to correct a minor informality. Claims 1, 5 and 11 have been canceled without prejudice to or disclaimer of the subject matter contained therein. Therefore, any rejections with respect to these claims have been rendered moot. Claims 2-4, 6-9 and 12-14 have been amended to further define the subject matter Applicant regards as the invention. Claim 10 has been rewritten in independent form given the Office Action's indication that claim 10 contained allowable subject matter.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier. Thus, claims 2-4, 6-10 and 12-14 are presently pending in this application for consideration.

Applicant respectfully submits that the claims are patentably distinguishable over the cited references as required by § 103. Applicant further submits that the cited references, whether considered alone or in any combination, fail to disclose Applicant's claimed paper supply device and image forming apparatus including *a shaft coupled to the paper supply roller and a driving mechanism connected to the shaft to rotate the paper supply roller, wherein the shaft is provided to oscillate around its one end portion while its other end portion is set to be free and the paper supply roller contacts with the separation roller to*

*supply the paper* as recited in amended independent claims 3, 8 and 13. The cited references do not suggest this claimed feature. This distinction will be discussed in greater detail below.

**THE CLAIMS DISTINGUISH OVER THE CITED REFERENCES**

Claims 1-9 and 11-14 stand rejected as being obvious over the combination of Taniyama and Matsuyoshi. According to the Office Action, Taniyama discloses all of the elements of the claimed invention except for a weight to press fit the paper supply to the separation roller by applying a load to the paper supply roller. This deficiency is allegedly fulfilled by the teachings of Matsuyoshi.

Applicant has amended claims 3, 8 and 13 to place them in independent form and to more clearly recite that the shaft is coupled to the paper supply roller and a driving mechanism is connected to the shaft to rotate the paper supply roller. In addition, the shaft is provided to oscillate around its one end portion while its other end portion is set to be free. Applicant respectfully submits that the claims as amended distinguish over the cited references. Neither Taniyama nor Matsuyoshi discloses the arrangement of the shaft.

Applicant relies on MPEP § 2143, which states that:

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that at least the first and third criteria of MPEP § 2143 have not been met in the Office Action with respect to the claims.

**The Cited References Do Not Suggest All Claim Recitations**

Even if the first requirement of MPEP § 2143 was satisfied in the Office Action (which it is not, as explained below), the cited references still do not meet the third

requirement, which is that “the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Embodiments of the present invention are directed to a paper supply roller or an image forming device including *inter alia*, a paper supply roller, a separation roller and a weight. The paper supply roller rotates in a paper supplying direction and the separation roller holds the sheets of paper jointly with the paper supply roller. The weight is provided to press fit the paper supply roller to the separation roller by applying a load to the paper supply roller. Each of the amended independent claims requires ***a shaft coupled to the paper supply roller and a driving mechanism connected to the shaft to rotate the paper supply roller, wherein the shaft is provided to oscillate around its one end portion while its other end portion is set to be free and the paper supply roller contacts with the separation roller to supply the paper.*** Support for the amendments to the claims can at least be found on page 7, lines 12-26 and page 11, lines 13-15 of the present specification. Each of the references, whether considered alone or in combination, fails to teach or suggest this claimed feature.

The Office Action correctly notes that Taniyama fails to disclose the claimed weight to press fit the paper supply roller to the separation roller. The Office Action asserts that this deficiency is allegedly fulfilled by Matsuyoshi. Applicant respectfully submits, even assuming *arguendo* that Matsuyoshi discloses this missing feature, Matsuyoshi also fails to disclose the claimed ***shaft...provided to oscillate around its one end portion while its other end portion is set to be free.***

Matsuyoshi is directed to a carrier for carrying sheets of paper. As illustrated in the figure, the carrier includes paper discharge rollers 1 formed on a paper discharge roller shaft 5. Paper discharge driven rollers 3 are provided above the paper discharge rollers 1. The paper discharge driven rollers 3 are provided on a paper discharge driven roller shaft 6 with a hollow cylindrical weight 4 provided there between. According to Matsuyoshi, papers are positioned between the paper discharge rollers 1 and the paper discharge driven rollers 3 and conveyed by the fictional force of the paper discharge rollers 1 and combined weight of the paper discharge driven rollers 3, the weight 4 and the paper discharge roller shaft 6.

However, Matsuyoshi fails to disclose the claimed *shaft...provided to oscillate around its one end portion while its other end portion is set to be free*. This is because the paper discharge roller shaft 6 has paper discharge driven rollers 3 provided on both of its ends. Thus, there is no end portion set to be free as claimed. As such, Matsuyoshi cannot remedy the deficiency of Taniyama. Therefore, independent claims 3, 8 and 13 and all claims dependent therefrom are allowable.

In sum, even if the first requirement of MPEP § 2143 is satisfied, the third requirement of MPEP § 2143 is not satisfied in the Office Action, since the cited references do not teach each and every element of the present invention. Thus, the present claims are allowable.

Lack of Suggestion or Motivation to Modify or Combine the References

MPEP § 2143.01 states that “the *prior art must* suggest the desirability of the invention.” (MPEP § 2143.01, subsection 1, emphasis added.) The Office Action appears to rely solely on Applicant’s disclosure for motivation to modify the reference to arrive at the invention relating to a paper supply device and an image forming device. The Office Action cites nothing in the *prior art* that provides motivation to modify the reference to arrive at the invention of amended independent claims 3, 8 and 13. There is nothing in either of the cited references that suggests the desirability of Applicant’s invention, and the Office Action does not provide evidence that motivation to modify Taniyama is in the knowledge generally available to one of ordinary skill in the art.

Applicant submits that the motivation proffered in the Office Action to combine the references is not sufficient. The Office Action states a result of general implementation of the references: the combination would “improve stability and reliability of the paper supply device by ensuring that the supply roller and the separation roller remain in contact with each other.” However, Applicant respectfully submits that a *result* is not the same as a *reason why* one of ordinary skill in the art would be motivated to combine the references, however desirable those results may be. If motivation to combine references to establish a *prima facie* case of obviousness could merely be satisfied by a result-oriented analysis of the prior art, the first requirement (and second requirement) of MPEP § 2143 would be completely vitiated.

This is because by identifying references that teach each individual element of a claimed invention, implementation of the teachings of the cited references almost always necessarily provides results according to a given invention under examination. Indeed, such an analysis relies on impermissible circular reasoning.

In contrast to the result-oriented analysis proffered in the Office Action, the MPEP specifically states that “the prior art must suggest the desirability of the claimed invention.” The Office Action, in relying only on results, does not identify where the prior art suggests the desirability of the paper supply device of claims 3 and 8 or the image forming apparatus of claim 13.

In summary, because of the lack of suggestion or motivation in the prior art to modify the reference, the first requirement of MPEP § 2143 has not been met and, hence, a *prima facie* case of obviousness has not been established.

Applicant respectfully submits that independent claims 3, 8 and 13 are patentably distinguishable over the cited references and thus, allowable. Moreover, since independent claims 3, 8 and 13, are allowable, claims 2, 4, 6, 7, 9, 12 and 14 are also allowable by virtue of their direct or indirect dependence from allowable independent claims 3, 8 and 13 and for containing other patentable features. Further remarks regarding the asserted relationship between any of the claims and the cited references is not necessary in view of their allowability. Applicant’s silence as to the Office Action’s comments is not indicative of being in acquiescence to the stated grounds of rejection.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

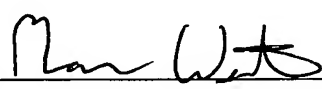
The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,


otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date 8/22/06

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